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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2479.1078-000

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on 04/05/06

Signature Ellen T. Spear

Typed or printed name Ellen T. Spear

Application Number

09/774,545

Filed

01/31/2001

First Named Inventor

Leslie M. Brooks

Art Unit

2151

Examiner

Phillips, Hassan A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 44,348

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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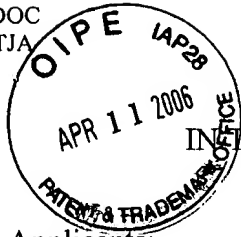
4/5/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Leslie M. Brooks and Kevin L. Farley

Application No.: 09/774,545 Group: 2151

Filed: January 31, 2001 Examiner: Phillips, Hassan A.

Confirmation No.: 3228

For: Adaptive Compression in an Edge Router

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PRE-APPEAL BRIEF CONFERENCE REMARKS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is being submitted together with a Notice of Appeal under 37 C.F.R. § 41.31 and in support of a Pre-Appeal Brief Request for Review in the above-identified application.

In the above-captioned application, a Final Office Action dated January 9, 2006 ("subject Final Office Action") finally rejected Claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over Gillon (U.S. Patent No. 5,838,927) in view of Christensen et al. (U.S. 5,555,377).

Applicants believe this rejection of record is clearly not proper and is without basis. In support of this position, the below presents clear legal and/or factual deficiencies in the rejections.

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1. The subject Final Office Action at page 4, paragraph 8 states Gillon teaches “. . . associating the selected state of data link compression with the protocol data unit to enable or disable a compression process adapted to compress protocol data units in an adaptive manner” (see Gillon, column 2, lines 21-31). However, Gillon provides a system having a *continuously running compression stream*. The continuously running compression stream receives data when a compression unit in communication with the continuously running compression stream detects a data packet with a content header indicating data is compressible (see Gillon, column 5, lines 52-56). Gillon does not suggest disabling the compression process or providing a mechanism that disables the compression process as argued on the pages 7-8 in the paper filed on October 19, 2005.
2. On page 5, second full paragraph of the subject Final Office Action, the Final Office Action states that Christensen “. . . teaches enabling or disabling a compression process adapted to compress protocol data units in an adaptive manner for optimizing compression efficiency” (see Christensen, column 2, lines 1-18). However, the cited discussion of Christensen enables compression based on network activity. Christensen does not teach a compression process adapted to compress protocol data units in an adaptive manner as claimed by Applicants in now pending Claim 1 (see paper filed on October 19, 2005).
3. At pages 3 and 4, part 3 (Response to Arguments section) of the subject Final Office Action, the Final Office Action states Gillon teaches “. . . monitoring the data type of data streams, making an intelligent guess, deciding whether or not to compress the stream of data.” However, Applicants’ Claim 1 recites, “associating the selected state of data link compression with the protocol data unit to enable or disable a compression process adapted to compress protocol data units in an adaptive manner.” Thus, the subject Final Office Action does not address how Gillon discloses associating a selected state of data link compression with the protocol data unit to enable or disable a compression process, e.g., Applicants’ Claim 1.

4. In addition to the cited references not meeting the claim limitations recited in the foregoing paragraphs 1-3, the subject Final Office Action lacks essential elements for making a prima facie case of obviousness.

More specifically, MPEP 2143.01 provides there must be some suggestion or motivation to modify the references. As argued at pages 9 and 10 in the paper filed October 19, 2005, MPEP 2143.01 sets forth multiple tests, including: (a) the prior art must suggest the desirability of the claimed invention; (b) where the teachings of the prior art conflict, the Examiner must weigh the suggestive power of each reference; (c) fact that references can be combined or modified is not sufficient to establish prima facie obviousness; (d) fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness; (e) the proposed modification cannot render the prior art unsatisfactory for its intended purpose; and (f) the proposed modification cannot change the principle of operation of a reference. The letters (a)-(f) associated with the tests are not found in MPEP 2143.01, but they are used herein for reference purposes. Reasons the limitations of now pending Claim 1 overcome each of the lettered tests is presented, in turn, below. Note that these reasons were set forth in the paper filed on October 19, 2005 on pages 9 and 10 and are reproduced in these Remarks for the convenience of the Panel.

With regard to test (a) ("prior art must suggest the desirability of the claimed invention"), neither Gillon nor Christensen suggests the desirability for optimizing data compression by enabling or disabling a compression process. Gillon teaches away from such a technique, evidenced by disclosure of a continuous compression process (see Gillon, column 2, lines 21-31 and column 5, lines 48-57), and Christensen enables/disables compression as a result of exceeding a threshold of network activity, e.g. enabling/disabling does not optimize compression (see Christensen, column 2, lines 1-18). Thus, neither reference, alone or in combination, suggests desirability for optimizing data compression by enabling or disabling a compression process.

With regard to test (b) ("where the teachings of the prior art conflict, the Examiner must weigh the suggestive power of each reference"), Gillon's continuously running compression process conflicts with Christensen's enabled and disabled compression process. Therefore, the

suggestive power of each reference must be weighed. Since Christensen is only being used to show that, “‘selectively controlling a state of a compression algorithm’ was known at the time of the invention,” as stated in part 5 of the Office Action mailed on May 19, 2005, and “such a teaching is implicit in the teachings of Gillon,” as also stated in part 5 of the Office Action mailed on May 19, 2005, Applicants respectfully submit that Gillon’s continuously running compression process weighs more heavily. Thus, for reasons presented above in paragraph 1 and test (a) with respect to the phrases “continuously running compression stream” and “continuous compression process,” the combination of Gillon and Christensen fails test (b).

With regard to test (c) (“fact that references can be combined or modified is not sufficient to establish prima facie obviousness”), Applicants submit that this is the case in terms of combining Gillon and Christensen; therefore, test (c) fails.

With regard to test (d) (“fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness”), Applicants again respectfully submit that this is the case in terms of combining Gillon and Christensen; therefore, test (d) fails.

With regard to test (e) (“the proposed modification cannot render the prior art unsatisfactory for its intended purpose”) and test (f) (“the proposed modification cannot change the principle of operation of a reference”), Applicants respectfully submit the following:

Combining the enabling and disabling compression process disclosed by Christensen (see Christensen, Fig. 5) and the continuously running compression stream of Gillon changes the basic operation of the system disclosed by Gillon. Such a combination would also cause the Gillon system to fail for its particular purpose, as it would add inherent latency in data transmission. Moreover, such a combination would require modification of the Gillon system beyond simply replacing its compression process with a compression process that can be enabled and disabled. In particular, (i) Gillon’s continuously running compression stream would have to be modified to be discontinuous to account for non-compressible protocol data packets being added to the compression stream of Fig. 4B of Gillon (change in basic operation), (ii) Gillon discloses (column 5, lines 52-56) that only compressible protocol data packets are added to the compression stream (change in basic operation), (iii) allowing the Gillon continuous compression process to be enabled and disabled would add inherent latency to the data

transmission (failure for its particular purpose), and (iv) a process that associates states of compression would have to be added to the Gillon system in addition to the Christensen enabled/disabled compressor (modification). Therefore, Applicants respectfully submit that tests (e) and (f) fail.

Because MPEP 2143.01, tests (a)-(f) as presented above, fail, Applicants respectfully submit that the combination of Gillon and Christensen fails to achieve the basic requirements of a prima facie case of obviousness.

In summary, (a) there is no motivation to combine the references because each is directed to solving a different problem; (b) even if combined, the references do not teach or suggest all the claim limitations (for example, see paragraph 1 above, "continuously running compression stream"); and (c) the references cannot be combined without modification or causing them to fail for their respective particular purposes. Thus, a prima facie case of obviousness has not been met.

Accordingly, it is respectfully requested that the Panel find:

- (i) all existing claims are in condition for allowance and the application should pass to issue, or, in the alternative,
- (ii) there is allowable subject matter in the claims and prosecution on the merits should be reopened with an appropriate office communication.

Respectfully submitted,

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